



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/176,422 10/21/98 WILK

G TI-24742

023494 MMC2/0221
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EXAMINER

BEREZNY, N

ART UNIT

PAPER NUMBER

2823

DATE MAILED: 02/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/176,422

Examiner

Neal Berezny

Applicant(s)

WILK ET AL.

Art Unit

2823

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 February 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);
 - (b) ☐ they raise the issue of new matter. (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

4. ☐ Applicant's reply has overcome the following rejection(s): _____.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: _____.
- Claim(s) objected to: 23-25.
- Claim(s) rejected: 1-25.
- Claim(s) withdrawn from consideration: _____.
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
11. ☐ Other: _____

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ADVISORY ACTION

1. The shortened statutory period for reply expires **THREE MONTHS** from the mailing date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of the final rejection.

2. Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

3. The request for consideration, dated 2/2/01, has been entered and considered but does not overcome the rejection because of the following reasons:

A. Applicant's response, par.1, is not convincing and fails to address the issues. Employing applicant's example, claim 24 does not contain a **process** limitation, and therefore does not further limit claim 18. In applicant's example, if one were to employ the process of claim 18 and were to produce a number of devices, some with 8 MV/cm, some with 11 MV/cm, and some with 13MV/cm, by applicant's admission and argument each group of devices would receive different protection under the claims, even though all devices are produced by identically claimed processes. Claims 23-25 merely sort the results of the structures produced by a single indistinguishable process, and since applicant has elected by original presentation the process invention, the dependent claims must be limited by differences in the process. Applicant has the

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burden to describe the process limitations both in the claims and the specifications that are responsible for producing different structures and results.

B. Applicant's responses, par.2-3, are based on the argument that since Nayar's process allegedly confesses oxides with high fixed charges and allegedly does not advertise <3% uniformity, and therefor must not have achieved <3% uniformity, must have a process different than applicant's, even though applicant fails to differentiate between the two processes. Applicant then concludes that it would not be obvious to apply a low quality oxide as a gate oxide. Applicant is merely asserting a superior oxide without differentiating between the two processes to account for applicant's superior results. Further, obviousness is also demonstrated by the long standing desire and effort in the art, including Nayar's attempt, to produce a superior oxide to be used as a thin and uniform gate oxide. Clearly, one skilled in the art would have anticipated using Nayar's process if it were to produce a high quality oxide. Once again it must be emphasized that the issue of patentability is based on the process claimed and not on the mere allegation of a superior result.

C. Applicant's response, par.4, argues that providing an atomically flat GaAs substrate surface is not an obvious variation of providing an atomically flat Si substrate surface, merely because the substrates are composed of different materials. Given that applicant has failed to disclose the critical nature or unexpected results arising therefrom, and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for its intended use, patentability cannot be asserted. *In re Leshin*, 125 USPQ 416.

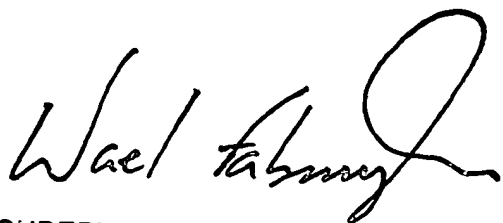
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CONCLUSION

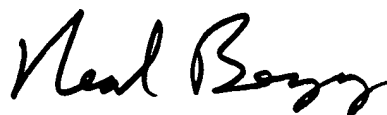
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neal Berezny whose telephone number is (703) 305-1481. The examiner can normally be reached on Monday to Friday from 7:00 to 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached at (703) 308-4918. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



SUPERVISORY PRIMARY EXAMINER
TECHNOLOGY CENTER 2800



2-15-01

Neal Berezny

Patent Examiner

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